

Remarks/Arguments

The Examiner objected to specification on the basis that the various sections of the specification should be preceded by their respective headings. In complying with the Examiner's requirement for correction of the specification the Applicant submits a substitute specification filed under 37 CFR 1.125(b). The substitute specification contains no new matter. The Applicant has only added the headings suggested by the Examiner and corrected typographical or grammatical errors. The Applicant submits a Substitute Specification in clean form without markings as to amended material and a marked up version of substitute specification showing all the changes, including the matter being added to and matter being deleted from, to the specification of record. No new matter has been added.

The Examiner has required a drawing showing the embodiment as per claim 13, wherein the piston and the engaging section are found as separate parts. The Applicant has canceled claim 13 and as such respectfully requests that the Examiner withdraws the objection requiring a drawing.

After entry of the present amendment, Claims 1, 3-5, 7-12, 14-15 and 18 are pending and Claims 2, 6, 13, 17 and 19-30 have been cancelled without prejudice.

1. Rejection of Claims 1-16 under 35 U.S.C. §112

The Examiner has rejected Claims 1-16 and 18 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Applicant respectfully requests reconsideration of these claims based on the present amendment.

The Examiner rejected Claims 1 stating " 'the application of bone cement' and 'the reception' each lacks a prior antecedent." Claim 1 has been amended to more clearly define the invention. More specifically, Applicant has amended "the" to "an" to provide proper antecedent basis. Additionally, the Applicant has amended "the reception" to "receiving" to more clearly define the invention. Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected Claim 10 stating that "and/or" was indefinite. The Applicant has amended Claim 10 with the phrase "at least one" to state this more clearly. Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected Claim 11 stating that " 'the other tooth flanks' and 'the other flank of the thread section' each lacks a prior antecedent." Claim 11 has been amended to more clearly define the invention. Specifically, "the other" has been deleted and replaced with "an engaging section." (Spec. Pg.4, lines 9-15). The claims have been amended to state this more clearly. The Examiner also rejected

Claim 11 stating that "and/or" was indefinite. The Applicant has also amended Claim 11 with the phrase "at least one" to state this more clearly. Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected Claim 16 stating that " 'the side' lacks proper antecedent basis." The Applicant has amended Claim 16 by deleting such phrase. Applicant respectfully requests that this rejection be withdrawn.

As suggested by the Examiner, the Applicant has amended Claim 18 by changing "a pplication" to "application." Applicant respectfully requests that this rejection be withdrawn.

2. Rejection of Claims 1-16 and 18 under 35 U.S.C. §102(b) and §103(a)

The Examiner rejected Claims 1-12, 14 and 15 under 35 U.S.C. 102(b) as anticipated by Kokernak et al., U.S. Patent 4,583,974. The Examiner rejected Claim 13 under 35 U.S.C. 103(a) as obvious over Kokernak. The Examiner rejected Claims 16 and 18 under 35 U.S.C. 103(a) as obvious over Kokernak in view of Jacoby, Jr., U.S. Patent 2,711,733. For the reasons presented below, Applicant submits that the invention described in Claims 1-16 and 18 is neither anticipated by Kokernak nor obvious over Kokernak et al., in view of Jacoby, Jr.

A. Present Invention

The present invention is directed to an apparatus for the application of bone cement which contemplates direct displacement of the liquid cement in a short period, such rapid displacement of the liquid cement creates a strong counter pressure. (Page 2, lines 16-19). Whereby, when the counter pressure becomes so large that it cannot be overcome by direct displacement the piston is then switched to the mode of "displacement of the piston by screw movement." (Page 2, lines 16-20). The present invention as now claimed is directed to using a **bias** provided at the housing such that the longitudinal displacement is effected when the engaging section is turned. The present invention as now claimed provides the advantage of stabilizing the apparatus when the screw movement is used to overcome the great pressure.

B. Kokernak

Kokernak is directed to syringe for inflation of balloon catheter. Kokernak does not describe or suggest using such a bias as now claimed in the present invention. Further, it would not be obvious of one of ordinary skill to modify Kokernak to include such a bias. This is because Kokernak states "with the latch in the open position knob 22 can be moved axially until an approximate, but lower than

ultimately desired pressure value is read on the gauge. The latch is then closed and knob 22 is rotated to trim the catheter to the exact pressure desired. " (Column 3, lines 48-53). Thus, Kokernak uses the screw movement to add pressure when the pressure is low, whereas the present invention teaches how to overcome pressure when it is too great. Kokernak does not address the problem of high pressure and as such it would not have been obvious to one of ordinary skill in the art to include such a bias. *use!*

C. Jacoby, Jr.

Jacob, Jr. is directed to syringe or cannula for injecting liquid. Jacob, Jr. does not describe or suggest moving the plunger by a screw movement in a situation when the pressure is too great. Moreover, Jacob, Jr. does not disclose either using a bias in the apparatus or a screw movement for displacing the liquid.

D. Rejection under 35 U.S.C. §102(b)

To anticipate an invention, each and every element of a claim must be found in a single prior art reference. MPEP 2131; Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claims 1, 3-5, 7-12, and 14-15 as now amended require an apparatus to have a bias. Kokernak discloses no such use of a bias and therefore Kokernak does not describe or suggest all elements of the present invention. Thus, since anticipation under 102 requires the disclosure in a single prior art reference of each element of the claim, Claims 1, 3-5, 7-12, and 14-15 are not anticipated. Applicant respectfully requests that this rejection be withdrawn.

E. Rejection under 35 U.S.C. §103(a)

The Federal Circuit has stated that it is necessary, in order to support a rejection of claims under §103(a) using a combination of references, that there be a teaching or suggestion in one or more of the cited references to combine the elements of the claimed invention. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529 at 1531-32 (Fed.Cir. 1988); *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 U.S.P.Q. 929 at 933 (Fed.Cir. 1984); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 at 311 (Fed.Cir. 1983). The mere fact that the prior art can be modified does not make the modification obvious, unless the prior art taught or suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

For the reasons stated above Claims 16 and 18 are not obvious in view of

Kokernak and in further view of Jacoby, Jr. As now claimed the present invention is directed to using a bias and neither Kokernak nor Jacob disclose an apparatus with a bias. It would not have been obvious to one of ordinary skill in the art to include such a bias because neither Kokernak nor Jacoby, Jr. address the problem of high pressure. Kokernak uses the screw movement to add pressure when the pressure is low, whereas the present invention teaches how to overcome pressure when it is too great. Further Jacoby, Jr. does not cure the deficiencies of Kokernak because Jacob, Jr. does not describe or suggest moving the plunger by a screw movement in a situation when the pressure is too great. Therefore, the reliance on the reference to sustain a rejection under §103(a) is improper. Claims 16 and 18 are not obvious. Applicant respectfully requests that this rejection be withdrawn.

In view of the foregoing, Applicant respectfully requests the passage of the application to issue. If there are any other matters that need to be addressed prior to allowance, please call the undersigned at the telephone number recited below for a telephone disposition. The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135. In the case of overpayment, please credit the same account.

Respectfully submitted,
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